



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,406	12/17/2001	Michael Wayne Brown	AUS920010842US1	3586

43307 7590 09/12/2005

IBM CORP (AP)
C/O AMY PATTILLO
P. O. BOX 161327
AUSTIN, TX 78716

EXAMINER

BARNIE, REXFORD N

ART UNIT	PAPER NUMBER
----------	--------------

2643

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/023,406

Applicant(s)

BROWN ET AL.

Examiner

REXFORD N. BARNIE

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-35 and 37-39 is/are rejected.
- 7) ☐ Claim(s) 12, 24 and 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some * c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Rexford N. Barnie
REXFORD BARNIE
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-39 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/023,407. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to the same subject matter with minor wording variations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 13-23, 25-35 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards et al. (US Pat# 6,275,940) in view of Katz et al. (US 2002/0055906).

Regarding claim 1, Edward teaches a method for verifying information during telemarketing information including receiving a request to originate a transaction for a service provided by a caller from an origin device; authenticating an identity of a called party answering the call and responsive to receiving an acceptance of the call by the called party, storing billing information including a telephone number and billing account information in (see col. 3, cols. 11-13). According to (see col. 13), phone bill and data including credit information can be verified.

It's notoriously well known in the art to receive calls from telemarketers associated with service provider to extend a subscription services wherein a user can pay for instance a flat monthly rate or subscription fee for services subscribed.

Edward fails to teach billing services to an account associated with the service subscribed.

Katz teaches a method and apparatus for intelligent selection of goods and services in telephonic and electronic commerce wherein telemarketers can generate an

outbound call or receive an inbound call to/from a customer. The interaction between the two parties can result in authorization of an account for the user to whom a service is being provided (see paragraph [0039], [0040], [0043], [0048], [0054-0058]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Katz into that of Edwards et al. thus making it possible to bill a called party for a provided service after authentication of an account to avoid loss of revenue.

Regarding claims 2-5, The combination renders the claimed subject matter by providing a service only after an account of a user has been verified after which a go ahead can be given to the service provider

Regarding claims 5-6, The examiner takes official notice that it's well known to receive calls from vendors or sale calls for purchase of a product wherein a called party can be notified of a product being sold and for how much. Transmission of caller ID is known when available.

Regarding claims 7-10, The combination teaches the ability to make an outbound or receive an inbound call for the purpose of vending a product or service. Voice dialing or digit dialing is notoriously well known.

Regarding claim 11, A predictive dialer can be used in making an outgoing call based on stored profile information.

Regarding claim 13, Edward teaches a method for verifying information during telemarketing information including receiving a request to originate a transaction for a service provided by a caller from an origin device; authenticating an identity of a called

party answering the call and responsive to receiving an acceptance of the call by the called party, storing billing information including a telephone number and billing account information in (see col. 3, cols. 11-13). According to (see col. 13), phone bill and data including credit information can be verified.

It's notoriously well known in the art to receive calls from telemarketers associated with service provider to extend a subscription services wherein a user can pay for instance a flat monthly rate or subscription fee for services subscribed.

Edward fails to teach billing services to an account associated with the service subscribed by using a billing controller.

Katz teaches a method and apparatus for intelligent selection of goods and services in telephonic and electronic commerce wherein telemarketers can generate an outbound call or receive an inbound call to/from a customer. The interaction between the two parties can result in authorization of an account for the user to whom a service is being provided (see paragraph [0039], [0040], [0043], [0048], [0054-0058]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Katz into that of Edwards et al. thus making it possible to bill a called party for a provided service after authentication of an account to avoid loss of revenue.

Regarding claims 14-23 and 26-35, see the explanation as set forth rejecting the claimed subject above above.

Regarding claim 25, Edward teaches a method for verifying information during telemarketing information including receiving a request to a originate a transaction for a

Art Unit: 2643

service provided by a caller from an origin device; authenticating an identity of a called party answering the call and responsive to receiving an acceptance of the call by the called party, storing billing information including a telephone number and billing account information in (see col. 3, cols. 11-13). According to (see col. 13), phone bill and data including credit information can be verified.

It's notoriously well known in the art to receive calls from telemarketers associated with service provider to extend a subscription services wherein a user can pay for instance a flat monthly rate or subscription fee for services subscribed.

Edward fails to teach billing services to an account associated with the service subscribed.

Katz teaches a method and apparatus for intelligent selection of goods and services in telephonic and electronic commerce wherein telemarketers can generate an outbound call or receive an inbound call to/from a customer. The interaction between the two parties can result in authorization of an account for the user to whom a service is being provided (see paragraph [0039], [0040], [0043], [0048], [0054-0058]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Katz into that of Edwards et al. thus making it possible to bill a called party for a provided service after authentication of an account to avoid loss of revenue.

Regarding claims 37 and 39, Edward teaches a method for verifying information during telemarketing information including receiving a request to a originate a transaction for a service provided by a caller from an origin device; authenticating an

Art Unit: 2643

identity of a called party answering the call and responsive to receiving an acceptance of the call by the called party, storing billing information including a telephone number and billing account information in (see col. 3, cols. 11-13). According to (see col. 13), phone bill and data including credit information can be verified.

It's notoriously well known in the art to receive calls from telemarketers associated with service provider to extend a subscription services wherein a user can pay for instance a flat monthly rate or subscription fee for services subscribed.

Edward fails to teach billing services to an account associated with the service subscribed.

Katz teaches a method and apparatus for intelligent selection of goods and services in telephonic and electronic commerce wherein telemarketers can generate an outbound call or receive an inbound call to/from a customer. The interaction between the two parties can result in authorization of an account for the user to whom a service is being provided (see paragraph [0039], [0040], [0043], [0048], [0054-0058]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Katz into that of Edwards et al. thus making it possible to bill a called party for a provided service after authentication of an account to avoid loss of revenue.

Regarding claim 38, the combination teaches the possibility of receiving credit card info to bill a provided services such as taught by Katz.

Allowable Subject Matter

Claims 12, 24 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **REXFORD N BARNIE** whose telephone number is 571-272-7492. The examiner can normally be reached on M-F 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CURTIS KUNTZ can be reached on 571-272-7499. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PRIMARY EXAMINER
REXFORD BARNIE
09/06/05


REXFORD BARNIE
PRIMARY EXAMINER